

Applicant: Ganesan
Filed: October 30, 2003
Application No.: 10/695,946

Amendments to the Drawings

In response to the Examiner's request, a complete set of Formal Drawings are submitted herewith. The new Formal Drawings of FIGS. 1-15 will replace the original FIGS. 1-15. Applicants respectfully submit that the new Formal Drawings are in compliance with 37 C.F.R. § 1.121(d).

Attachment: 15 Replacement Sheets

Remarks

The present amendment is responsive to the Non-Final Office Action mailed December 20, 2006. Claims 32 - 66 remain pending in this application. Claims 32, 33, 38, 39, 44, 60 and 64-66 have been amended, and Claims 34, 37, 40 and 43 have been cancelled. New Claims 67-70 have been added. Applicants respectfully submit that no new matter has been added by this amendment. Reconsideration of the application, as amended, is requested.

Objections to the Drawings

In the Office Action, the Examiner objected to the drawings stating that the drawings are difficult to read. Correcting drawing sheets in compliance with 37 C.F.R. 1.121(d) were required by the Examiner.

In Response, Applicants are submitting new formal drawings in conjunction with the present Amendment and Response. New FIGS. 1-15 will replace the original FIGS. 1-15. Applicants respectfully submit that the new Formal Drawings are clear and in compliance with 37 C.F.R. § 1.121(d).

Double Patenting Rejection

In the Office Action, the Examiner rejected Claims 32-66 on the ground of nonstatutory obvious-type double patenting as being unpatentable over Claims 1-31 of U.S. Pat. No. 6,678,664 to Genesan.

In response, a terminal disclaimer has been filed along with this Office Action Response to overcome the nonstatutory obvious-type double patenting rejection. As a result of the submitted terminal disclaimer, Applicants respectfully assert that the pending claims of the present application are in condition for allowance.

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, Claims 32, 37-38, 43-52 and 59-65 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,590,197 to Chen et al. ("Chen"). Applicants respectfully submit that the claims as amended are patentable over Chen.

1. Description of Chen

Chen generally relates to an electronic payment system and method in which account information is encrypted so that it cannot be misused by a merchant or vendor (see, generally, the Abstract and Column 3, lines 33-44). A cyber wallet is created that includes all the information necessary to carry out credit transactions over the Internet including account information, a user PIN number, a user ID, MAC, and any other information which might be needed (column 6, lines 12-18). This information is associated with a public key file, and the entire wallet is then provided to the customer (column 6, lines 18-22). When a customer makes an order, an authorization ticket that includes the account information is encrypted by the public key and communicated to the merchant (column 6, lines 32-36). After receiving the authorization ticket, the merchant then embeds or associates it with whatever information the merchant needs to provide the account servicer and forwards the authorization ticket to the account servicer (column 6, lines 47-51). The account servicer then uses a private key associated with the public key in order to decrypt the file and verify the status of the account (column 6, lines 51-53). If the transaction is approved, the account servicer then sends an approval message back to the merchant together with decrypted information necessary for the merchant's records (column 6, lines 53-56).

2. The independent Claims are allowable over Chen

As amended, independent Claims 32, 38, 44 and 60 are patentable over Chen. In particular, independent Claim 32 has been amended to now specifically recite the step of "receiving, at a central processing point and from a point of purchase, information identifying a purchaser without receiving any payment account information for a payment account of the purchaser." Similar amendments have been made to independent Claims 38, 44, and 60.

Support for these amendments can be found throughout the Specification of the present application. For example, the Invention Summary states at page 11, lines 14-18 that:

Further, using the invention as described herein, a purchaser need not disclose any payment account information, e.g., a bank account number, credit card account number or debit card account number, to sellers.

Additionally, at page 56, lines 8-13, the Specification states:

Accordingly, customers would be able to utilize the network to purchase goods and services both in-person and over the Internet using the same preexisting identifying information and without the need to disclose any information regarding the payment account.

Chen does not teach or suggest receiving information identifying a purchaser without receiving any payment account information for a payment account of the purchaser, as required by each of the independent claims of the present application. In marked contrast, Chen receives payment account information in conjunction with the information identifying a purchaser. When the cyber wallet of Chen is created, it includes information necessary to carry out credit card transactions remotely over the Internet including payment account information (column 6, lines 12-18). The necessary information is then included in an authorization ticket transmitted from the customer to the merchant when the customer makes an order (column 6, lines 32-36). The merchant receives this authorization ticket and embeds or associates it with whatever information the merchant needs to provide to the account servicer (column 6, lines 48-50). The authorization ticket is then forwarded to the account servicer for approval (column 6, lines 51-56).

In Chen, the account information is communicated from the purchaser to the merchant and then from the merchant to the account servicer. In other words, when the account servicer receives an authorization ticket from the merchant, that authorization ticket includes account information. The account information that is communicated through the merchant is encrypted

in Chen in order to prevent the merchant from acquiring and misusing the customer's sensitive account information. In fact, the entire purpose for encrypting information in Chen is to permit account information to be safely communicated through the merchant to the account servicer. This is made explicitly clear throughout the Specification of Chen. For example, in the Background of Chen, it is stated that:

[M]uch less attention has been paid to the problem of protecting the transaction facilitating information once the card has been authenticated, and in particular to the problem of misuse of the information by the merchant. (Column 1, lines 56-60).

Chen then goes on to state the principal objective of the invention as follows:

It is accordingly a principle objective of the invention to enable a party to make electronic payments using a new payment medium referred to herein as the cyber wallet. The cyber wallet may be thought of as an expansion of the credit card concept ... designed to enable the holder of the cyber wallet to make purchases over ... the Internet, with full protection of the electronic payment information from not only eavesdroppers, but also from remote merchants, without the need to verify the trustworthiness of the merchant. (Column 3, lines 33-44).

Accordingly, Chen discloses the receipt of an authorization ticket from an account servicer that includes both information identifying a purchaser and information associated with a payment account for the purchaser. Thus, Chen fails to teach or suggest the receipt of information identifying a purchaser without receiving any payment account information for a payment account of the purchaser, as required by each of the independent claims of the present application.

Additionally, the authorization of Chen is not the same as a confirmation of registration, as recited by each of the independent claims of the present invention. A registration confirmation is utilized to determine whether or not a purchaser is a registered user of a central processor or a payment service provider. The registration confirmation may be accomplished without the analysis of any price information. By contrast, the authorization of Chen is utilized to verify the status of an account and approve a transaction (column 6, lines 54-56). The information examined in the authorization process includes any information needed during the payment and authentication process (column 6, lines 12-19 and 48-50), including price information necessary to approve a credit card transaction.

For at least the reasons set forth above, Applicants respectfully submit that independent Claims 32, 38, 44 and 60 are allowable over Chen. Further, Applicants respectfully assert that dependent Claims 33, 35-36, 38-39, 41-42 and 44-66 are allowable as a matter of law as depending from an allowable base claim, notwithstanding their independent recitation of patentable features.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, Claims 33-35, 39-41, 55, 57 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of U.S. Pat. No. 3,554,727 to Braun ("Braun"). Claim 56 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Braun in view of U.S. Pat. No. 5,794,221 to Egendorf ("Egendorf"). Claims 53, 54 and 58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of U.S. Pat. No. 5,293,422 to Loiacono ("Loiacono"). Finally, Claims 36 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of U.S. Pat. No. 5,315,511 to Matsuura, et al. ("Matsuura").

Applicants respectfully assert that, in light of the current claim amendments, the rejections under 35 U.S.C. § 103 are moot. Neither Chen, Braun, Egendorf, Loiacono, nor Matsuura, either alone or in combination, teach or suggest each of the elements of amended independent Claims 32, 38, 44 and 60. Accordingly, Applicants respectfully submit that independent Claims 32, 38, 44 and 60 are allowable over Chen in combination with Braun,

Egendorf, Loiacono, and/or Matsuura. Additionally, Applicants respectfully assert that dependent Claims 33, 35-36, 38-39, 41-42 and 42-66 are allowable as a matter of law as depending from an allowable base claim, notwithstanding their independent recitation of patentable features.

Additionally, Applicants respectfully submit that dependent Claims 53 and 54 are allowable over the combination of Chen and Loiacono. The Office Action cites to Column 5, lines 60-64 of Loiacono in arguing that Chen in combination with Loiacono obviates dependent Claims 53 and 54. Loiacono is generally related to a system for making computer software consumable (see, generally, the Abstract). The completion of units of the software is monitored in a copy-protected region of a recording medium (e.g., a floppy disk) and, when all units have been completed, further access to the software is denied (see, generally, the Abstract). If multiple users are allowed for a particular piece of software, the multiple users are tracked by a registered user file (column 5, line 59 – column 6, line 6). The passage of Loiacono cited in the Office Action relates to the steps for verifying a registered user's status with the registered user file. The cited passage is reproduced below:

In the first step of the process (block 19), the user enters his or her identifier (e.g., his or her last name), and the program compares that identifier with the registered user file to determine if the user has or has not been previously registered. (Column 5, lines 60-64).

Applicants respectfully assert that the cited passage of Loiacono, either alone or in combination with Chen, fails to teach or suggest that “first information identifying the purchaser includes only a first type identifying information” and “third information identifying the purchaser includes the first type information and a second type identifying information,” as recited by dependent Claim 53. Loiacono only discloses the use of a user name in verifying the status of a registered user. There is no teaching or suggestion of a second type of identifying information in Loiacono. Chen fails to disclose the use of any information identifying the purchaser that is associated with a particular type. Accordingly, neither Loiacono nor Chen, either alone or in combination, teach

or suggest the claimed subject matter of Claim 53, and therefore, Claim 53 is in condition for allowance.

Additionally, neither Loiacono nor Chen, either alone or in combination teach or suggest that “the first type identifying information is limited to one or more of a name, an address, a driver’s license number and a passport number of the purchaser” and “the second type identifying information is limited to other than the name, the address, the driver’s license number and the passport number of the purchaser,” as recited by dependent Claim 54. As discussed above, Loiacono only discloses the use of a user name as identifying information of the purchaser. Additionally, Chen fails to specify any particular identifying information of the purchaser that is received from a seller. Accordingly, Claim 54 is allowable over both Loiacono and Chen.

Furthermore, Applicants respectfully assert that Loiacono is non-analogous art. Loiacono relates to systems for making computer software consumable and in no way relates to cashless transactions. One of ordinary skill in the art would, therefore, have no motivation to combine the teaching of Loiacono with that of Chen.

Patentability of New Claims

New dependent Claims 67-70 have been added by the present amendment. New dependent Claims 67 and 68 depend from independent Claim 32, and new dependent Claims 69 and 70 depend from independent Claim 38. Applicants respectfully submit that new dependent Claims 67-70 are not only patentable as being dependent from an allowable independent claim, but also for reciting patentable features, as discussed in detail below.

1. New dependent Claims 67 and 69

New dependent Claims 67 and 69 recite that “the information identifying the purchaser is received in a first communication; the instruction for paying for the purchase is received in a second communication; and the second communication is received subsequent to the first communication.” This limitation is supported in the Specification at least at page 47, line 20 – page 48, line 2 and at page 50, line 22 – page 51, line 13, which state:

The identifying information, payment type selection and price information is transmitted via the link 1235 to the communications network 1205 and from there to the central clearinghouse station 140 via link 1240, as indicated in step 1314. (Specification at page 47, line 20 – page 48, line 2)

The register processor directs the transmission of the bill in electronic form, with or without the digitized signature ... to the central clearinghouse station in step 1372 ... If the signatures match, a determination is made in step 1376 as to whether immediate or delayed payment has been selected. If delayed payment has been selected, billing information is generated by processor 140A in step 1378 and stored in database 140B1 in step 1380, as has also been previously described ... The registered user AA can now access the electronic billing information and authorize payment as has been previously discussed (Specification at page 50, line 22 – page 51, line 20).

An embodiment of the invention may receive two separate communications during a cashless transaction. A first communication may be utilized to authorize the status of the customer and the second communication may be utilized to provide an instruction for payment. The prior art cited in the Office Action fails to disclose the utilization of two separate communications during a cashless transaction. In particular, Chen only discloses the use of a single communication from the merchant to the account servicer during a transaction (column 6, lines 47-53). Accordingly, the Applicants respectfully submit that new dependent Claim 67 is patentable over the prior art, and therefore, in condition for allowance.

2. New dependent Claim 68

New dependent Claims 68 and 70 recite that “the received instruction for paying for the purchase on behalf of the purchaser is an instruction to subsequently pay for the purchase” and “billing information associated with the receiving instruction for paying for the purchase is stored.” Subsequent to the receipt of a payment authorization from the purchases, a payment for the purchase is directed on behalf of the purchaser. These limitations are supported in the Specification at least at page 51, lines 13-20, which state:

If delayed payment has been selected, billing information is generated by processor 140A in step 1378 and stored in database 140B1 in step 1380, as has also been previously described ... The registered user AA can now access the electronic billing information and authorize payment as has been previously discussed. (Specification at page 51, lines 13-20).


An embodiment of the invention may receive a subsequent request from a purchaser to pay a bill on behalf of the purchaser. The prior art cited in the Office Action fails to disclose the receipt of a subsequent payment authorization from the purchaser as part of a second communication to the payment service provider. In particular, Chen only discloses the use of a single communication from the merchant to the account servicer during a transaction (column 6, lines 47-53). Accordingly, the Applicants respectfully submit that new dependent Claim 68 is patentable over the prior art, and therefore, in condition for allowance.

Applicant: Ganesan
Filed: October 30, 2003
Application No.: 10/695,946

Conclusion

The applicants believe they have responded to each matter raised by the Examiner. Allowance of the claims is respectfully solicited. It is not believed that extensions of time or fees for addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



Rhett S. White
Attorney for Applicant
Registration No. 59,158

Date: February 21, 2007
SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996
(404) 853-8214
(404) 853-8806 (fax)
SAB Docket No.: 19564-0057